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Date: April 14, 2011

Signature:/Quyen Nguyen/..... (Quyen Nguyen)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/797,485
Confirmation No.: 3298
Filing Date: March 9, 2004
Inventor(s): Vahid SAADAT et al.
Title: ENDOLUMINAL TOOL DEPLOYMENT SYSTEM
Examiner: Matthew J. Kasztejna
Group Art Unit: 3779

APPELLANTS' REPLY BRIEF

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Commissioner for Patents
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Sir:

This is a Reply Brief filed in accordance with the provisions of 37 C.F.R. § 41.41 in response to the Examiner's Answer mailed February 14, 2011.

RESPONSES TO ARGUMENTS RAISED IN EXAMINER'S ANSWER

The Examiner's Answer includes several contentions that require a response. In particular, the "Response to Argument" section spanning pages 11-13 of the Examiner's Answer makes several points that are demonstrably incorrect, as shown below.

A. Zehel's Dual Conduit Body Cannot Comprise a "Single Tube"

In their Appeal Brief, Appellants noted that the Zehel exploratory device includes an elongated shaft having an inner conduit 10 and an outer conduit 11 – *i.e.*, two tubes – and argued based on this fact that the device therefore cannot satisfy the claim 67 limitation reciting a "main body comprising a single tube." (See Appeal Brief, pp. 13-15). In response, the Examiner argues (at page 11 of the Examiner's Answer) that the word "comprising" is an inclusive or open-ended transition and that this limitation therefore does not exclude the dual conduit Zehel device. In support of this argument, the Examiner cites Gillette Co. v. Energizer Holdings Inc., 405 F.3d 1367, 1371-73, 74 USPQ2d 1586, 1589-91 (Fed. Cir. 2005). Appellants do not disagree with the Examiner's general statement of the law, only its application to the facts of this case.

This case does not turn on the open-ended nature of the "comprising" transition. If it did, the Examiner's analysis (at pg. 11) based upon separating the outer conduit 11 from the inner conduit 10 and identifying only the outer conduit 11 as the "main body comprising a single tube" would be correct. Instead, this is an issue of a limitation that is simply missing from the Zehel device. The Examiner does not contest the fact that the Zehel device includes a shaft having two conduits. The Examiner simply does not attach sufficient meaning to the claim language reciting that the main body comprises a single tube. The word "single" in the claim requires a numerical limitation. Whether or not the term "comprising" is conventionally used as an open-ended transition, Zehel's dual conduit shaft cannot be a "main body comprising a single tube."

The Gillette case cited by the Examiner supports this result. As the Examiner explains in the Answer, the claim at issue in Gillette recited "a safety razor blade unit comprising a guard, a cap, and a group of first, second, and third blades." The court interpreted the claim to encompass razors with more than three blades, in part because of the "comprising" transitional phrase. However, the court also considered the question of

whether the terms “first, second, and third” in the claim were being used only to distinguish different elements of the claim, or whether they were intended to supply a numerical limit. Id. Only after determining that the claim language was not intended to assign a numerical limit did the court construe the claim to encompass razors with more than three blades. Id. That, however, is not the case here, where the limitation at issue explicitly requires “a single tube” – i.e., a numerical limitation. This case would be different – and the Examiner’s analysis would be correct – if the claim recited a main body “comprising a tube” or “comprising a first tube,” either of which would not exclude a dual conduit shaft. However, claim 67 recites a main body “comprising a single tube.” A numerical limitation is clearly the intent and the result. Given this result, the claim cannot encompass the Zehel device.

For all of these reasons, the Board should reject the Examiner’s argument that the phrase “main body comprising a single tube” may be interpreted to read on a device having a dual conduit shaft.

B. Zehel Does Not Disclose a Movable Scope

At pages 11-12 of the Answer, the Examiner argues that Zehel’s description of various optical fiber orientations within the described device is sufficient to satisfy the limitation recited in claim 67 of a scope extended through a lumen in the main body and being “movable through said lumen.” None of these arguments is sufficient to support a conclusion of anticipation of the claim.

In a first argument, the Examiner relies upon the following description from the Zehel patent (col. 8, lines 40-42):

The conduit 10 of the FIGS. 5-6 embodiment has a hollow interior space 29 through which functional equipment, such as air lines, optical fibers and so on may pass.

The Examiner’s argument is that the foregoing constitutes a description of a scope movably extended through a lumen of the main body. Appellants strongly disagree. The recitation in claim 67 of “a scope extended through” a lumen of the main body and “moveable through said lumen” plainly refers to a self-contained endoscope that is movable within the lumen of the main body. Such an interpretation is supported by the

conventional meanings of the words used in the claim, as well as Appellants' specification. (See, e.g., ¶ 0006 of the specification: "Traditional endoscopes comprise a small diameter 'snake-like' insertion tube having a distal end which is inserted into the orifice to the desired internal location."). Zehel's optical fibers may play a part in a visualization function of the described device, but that does not mean that the foregoing disclosure of optical fibers located in the interior space 29 of the Zehel inner conduit 10 constitutes the recited scope extended through a lumen of the main body. Zehel simply does not disclose "a scope extended through" a lumen of the main body that is "movable through said lumen." Rather, the reasonable understanding of the cited portion of the Zehel patent is that the optical fibers are connected to the "vision aperture for relaying video transmissions" that is located at the distal end 12 of the outer conduit 11. (See Zehel, col. 4, lines 21-25). Such a structure does not constitute "a scope" that is "movable through" a lumen of the main body.

Finally, in the section of the Answer spanning pages 12 to 13, the Examiner relies upon a description of the second embodiment of the Zehel patent provided at column 10, lines 20-30 and argues that:

The device thus can be an add-on device for an existing endoscope or the stiffening feature may be included in the basic endoscope and one or more segmented concentric devices of the invention may be used around the endoscope.

As noted in Appellants' main Brief (at page 15), this second embodiment (shown in FIGS. 7-8 of the Zehel patent) does not describe or suggest a main body "comprising a single tube," nor a second section of the main body that is "steerable relative to the first section," nor a second section of the main body that is located distally of the first section such that the pullwires are "fixed to the elongated main body at a location at or near a distal end of the first section." These conclusions are not contested by the Examiner in the Answer. Rather, the Answer states that "the rejection of claim 67 is not reliant upon the second embodiment of Zehel et al. (seen in Figures 7-8)." This statement is incorrect to the extent that the Answer does cite to the foregoing portion of the Zehel patent. Nevertheless, there can be no anticipation for the reasons stated above and in Appellants' main Appeal Brief.

For all of these reasons, the Board should reject the Examiner's argument that the Zehel patent describes or suggests a scope extended through a lumen in the main body and being "movable through said lumen."

CONCLUSION

For at least the reasons set forth above and the reasons set forth in Appellant's Appeal Brief, the claims currently pending in the application are patentable over the prior art of record, and the rejections of those claims under 35 U.S.C. §§ 102(e) and 103(a) are improper and should be withdrawn. Appellants respectfully request the Board to overturn the Examiner's rejections with instructions to allow the claims.

In the event the appropriate fee and/or petition is not filed herewith and the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with this filing to **Deposit Account No. 50-3973** referencing Attorney Docket No. **USGINZ00130**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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